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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,520	10/17/2000	Heiko Dassow	2345/137	6699
26646	7590	01/26/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			SWICKHAMER, CHRISTOPHER M	
		ART UNIT		PAPER NUMBER
		2662		
DATE MAILED: 01/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/673,520	DASSOW ET AL.
	Examiner Christopher M Swickhamer	Art Unit 2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 11-22 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                           | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

- The Examiner requests that all references cited in the background of the invention section be submitted for consideration.

### ***Specification***

2. The abstract of the disclosure is objected to because the abstract is too long. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- Referring to claim 11, the claim states “converting, within the digital data network, a coding of user information of the transmitted data between a data transmission in the voice connection path and a data transmission in the digital data network.” The description does not describe what the conversion process does to the user information in the digital network. The description states that the user information is converted, but fails to disclose what is happening to the data.

- Referring to claim 11, the claim states “to transmit the user information via the coded voice connection path on at least one first section of the digital data network and transmit the user information by a method suitable for the digital data network on at least one second section of the digital data network.” The specification describes sending the entire voice connection path across the data network. From the specification, it appears that the voice connection path is an analog path (pg. 1, lns. 16-18, pg. 10, lns. 18-21). Although the detailed description of the instant application describes doing this process (pg. 10, lns. 16-28), the description does not describe how one would implement the claimed system. The specification describes how the system is different from the prior art, i.e. not terminating the voice path at a transition 5 (pg. 10, lns. 18-21), but fails to disclose how applicant’s invention sends the voice connection path over the data network.

- Referring to claim 11, the claim states that the system reduces the “bandwidth when transmitting data between a sending terminal and a receiving terminal.” The specification does not describe how the bandwidth is reduced. The specification alleges that the system has a

savings in bandwidth, but it does not describe where the savings occurs. In fact, the specification describes using additional bandwidth due to sending the entire voice communication path (pg. 10, lns. 18-24). One skilled in the art would not know how the disclosed invention would result in a savings in bandwidth.

- Overall, the specification is not clear on what the voice communication path is in the context of the claimed invention, how the voice communication path is manipulated to be send across the heterogeneous networks, and what steps one skilled in the art would take to implement the disclosed invention.

- Referring to claim 19, the claim states “wherein at least one of the sending and receiving terminals is *connected directly or via a digital transmission link to the digital data network so as to avoid a need to first code* the data using either of the sending and receiving terminal for the data transmitting over the voice connection path and then a need to decode the coded data.” Neither the detailed description nor the figures show or describe this process. One skilled in the art would have undue experimentation to determine how to implement this claim as the specification does not describe the sending or receiving terminals connected directly or via a digital transmission link to avoid extraneous coding.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 11-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Adler et al (USP 2001/0035977 A1, hereafter Adler). All claims are being examined as best understood by the Examiner.

- Referring to claim 11, Adler discloses a method for reducing bandwidth (by compressing the data) when transmitting data between a sending terminal and a receiving terminal over a facsimile (voice) connection path using a digital data network, such as the Internet (abstract), the method comprising: converting, within the node of the digital data network, a coding of user information of the transmitted data between a data transmission in the voice connection path and a data transmission in the digital data network (convert from data transmitted over the PSTN to a format acceptable to the Internet) so as to transmit the user information via the coded voice connection path on at least one first section of the digital data network (at Node 1) and transmit the user information by a method suitable for the digital data network on at least one second section of the digital data network (over PRM1 Net, Fig. 1, paragraph [0028]-[0030], [0032]-[0034]).

- Referring to claim 12, Adler discloses the method as recited in claim 11 wherein the sending and the receiving terminals use a similar modulation method for transmitting the data over the voice connection path (paragraph [0003])

- Referring to claim 13, Adler discloses the method as recited in claim 11 wherein no special functional matching of the sending and receiving terminals is required for the converting (the data is transmitted across the Internet, so the data is received at the nodes without having to functionally match the sending and receiving terminals, paragraph [0032]-[0033]).

- Referring to claim 14, Adler discloses the method as recited in claim 11 wherein no special adaptation of the sending and receiving terminals to transmission characteristics of the digital data network is required for the transmission of the user information (paragraph [0032]-[0033]).

- Referring to claim 15, Adler discloses the method as recited in claim 11 wherein the transmitting the user information via the coded voice connection path on at least one first section of the digital data network is performed automatically by a context-related call-number translation during a connection setup so as not to be perceived by the sending and receiving terminals (the nodes translate the called number to an IP address, the originating and destination fax do not perform this translation, paragraph [0032]-[0033]).

- Referring to claim 16, Adler discloses the method as recited in claim 15 wherein the transmitting the user information via the coded voice connection path on at least one first section of the digital data network is performed such that end-to-end signaling of the sending and receiving terminals for a sending/receiving terminal control of the data transmission is terminated at a transition into the digital data network and is newly generated so as to integrate a control of the data transmission by the digital data network into the end-to-end signaling (the system sends acknowledgements from destination to source, where the signaling is converted back and forth from IP signaling to PSTN signaling depending on which network the signal is on, paragraph [0051]).

- Referring to claim 17, Adler discloses the method as recited in claim 11 wherein the sending and receiving terminals use different respective data transmission processes and further comprising temporarily storing and converting the transmitted data and signaling information so

as to match the respective data transmission processes of the sending and receiving terminals such that differences in the respective data transmission processes are not perceived by the sending and receiving terminals (paragraph [0035]).

- Referring to claim 18, Adler discloses the method as recited in claim 11 further comprising splitting the user information into data packets for the transmitting over the digital data network (change PSTN data to Internet data), a transmission rate of the data packets being flexibly adapted at a network transition to a bit rate transmitted by the sending terminal (Fig. 1, paragraph [0035]).

- Referring to claim 19, Adler discloses the method as recited in claim 11 wherein at least one of the sending and receiving terminals is connected directly or via a digital transmission link to the digital data network so as to avoid a need to first code the data using either of the sending and receiving terminal for the data transmitting over the voice connection path and then a need to decode the coded data (the fax machine is connected via a digital transmission link to the destination fax through the Internet, Fig. 1, paragraph [0032]-[0036]).

- Referring to claim 20, Adler discloses the method as recited in claim 1 I wherein the digital data network includes an interconnection of a plurality of individual data networks (Fig. 1).

- Referring to claim 21, Adler discloses the method as recited in claim 11 wherein the user information to be transmitted conforms to features of FAX class 3 (paragraph [0004]).

- Referring to claim 22, Adler discloses the method as recited in claim 1 I further comprising, before the transmitting over the digital data network, protecting the data by

cryptographic processes against passive monitoring, alteration and/or simulation of incorrect call data and/or contents (paragraph [0033]).

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Jacobi et al, USP 6,249,531 B1. Universal Voice/Fax/Modem Line over Compressed Media.
- Feder, USP 5,872,845. Method and Apparatus for Interfacing Fax Machines to Digital Communications Networks.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M Swickhamer whose telephone number is (703) 306.4820. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (703) 305-4744. The fax phone number for the organization where this application or proceeding is assigned is (703) 872.9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305.3900.

CMS  
January 14, 2004



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